

EXAMINER INTERVIEW SUMMARY

On August 2, 2004, Applicant's representatives (hereinafter "Applicants") participated in an interview with Examiners Gilligan and Kalinowski. During this interview the Applicants discussed the rejections of the claims in the final office action dated June 03, 2004. More specifically, the Applicants discussed the distinctions between claim 1 and the prior art cited by the Examiner.

Applicants pointed-out that the present invention is focused on providing a method for renewal of a prescription, which is a different from providing a refill of a prescription. The Examiner agreed with this distinction, but stated that U.S. Patent No. 6,198,383 to Sekura *et al.* (hereinafter "Sekura") does recite in claim 6 a method for renewal of a prescription. Applicants pointed-out that Sekura's specification lacks any support for a method for renewal of a prescription. In fact, the only time that the term renewal is recited in Sekura is in claim 6, which is a clear indication that the patent drafter erroneously included the term renewal instead of refill. The Examiner maintained his rejection despite the above arguments.

Applicants explained the operation of the system of the present invention to the Examiner. In particular, Applicants distinguished how the present system electronically generates a prescription renewal request and how this limitation is not found in any of the references cited by the Examiner. The Examiner argued that the first two elements of claim 1 can be broadly interpreted to mean that once a computer has notified a patient of the expiration of the patient's prescription, the patient can *sua sponte* request a prescription renewal from his physician, thereby generating a prescription renewal request. Applicants responded by directing the Examiners' attention to the preamble of the claim, which recites a method for renewing a prescription for a pharmaceutical via an electronic network. In other words, the method is performed over an electronic network and therefore the claim cannot be interpreted to include a patient walking into his/her physician's office and asking for a prescription renewal.

Despite the above, and in the interest of expediting allowance of the present application, Applicants agreed to clarify that the invention is performed without patient intervention. The Examiner stated that such an amendment would overcome the prior art of record, but could not vouch for any additional art that may be located in a subsequent search.

Applicants stated that they would forgo filing an appeal at this stage of prosecution and file an RCE together with the agreed upon amendments.

REQUEST FOR EXAMINER INTERVIEW

The Applicants also respectfully requested, in the telephone interview, that the Examiner grant an Interview prior to issuing any further Office Actions. The Examiner agreed to contact Applicants should any issues remain unresolved.

REMARKS

This communication is in response to the detailed Final Office Action mailed June 03, 2004. In this Action the Examiner rejected all pending claims, claims 1 and 3-30, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud (hereinafter “Mayaud”) in view of PR Newswire, nevoca.com Enhances Prescription Verification System (hereinafter “nevoca”) and further in view of U.S. Patent No. 6,198,383 to Sekura *et al.* (hereinafter “Sekura”).

Rejections Under 35 U.S.C. § 103

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.¹ As will be shown below, the combination of references do not teach all of the claim limitations of the independent claims of the present application. The rejected claims include three independent claims, namely claims 1, 22 and 24.

The Examiner states that the limitations of computer “monitoring an expiration date of a prescription” and “generating a prescription renewal request for the renewal of said prescription prior to said expiration date based on said computer monitoring” are not disclosed in either Mayaud or nevoca. *See* Office Action mailed June 03, 2004, paragraph 35. However, the Examiner relies on Sekura for disclosing these limitations. *Id.* Specifically, the Examiner states “Sekura teaches a method for monitoring the number of days until prescription renewal and alerting a user of the prescription renewal.” *Id.* at paragraph 6. Furthermore, the Examiner states the purpose of combining Sekura with Mayaud and nevoca is to aid a patient with managing various different medication regimes. *Id.*

Sekura discloses notifying a patient, of an approaching time for taking prescription medication, in order to help the patient monitor prescription compliance. *See* U.S. Patent No. 6,198,383 to Sekura, col. 1, ll. 21-23, 47-67, col. 2, ll. 1-15, col. 4, ll. 22-25, col. 12, ll. 62-63, and Abstract. For example, the Field of the Invention states the invention “aids patients in complying with instructions given by a physician for taking prescription medication.” *Id.* at col. 1, ll. 22-24. Furthermore, Sekura states that its object is directed to “a prescription

compliance device.” *Id.* at col. 1, l. 47 – col. 2, l. 15. Moreover, monitoring of the dosage disclosed in Sekura is done as a reminder for the patient that the time is nearing to take another dose and/or to alert the patient of the completion or nearing the completion of the prescription. *Id.* at col. 4, ll. 19-25, 50-51, and col. 16, ll. 39-43. After the device of Sekura alerts the patient, the patient must physically initiate the prescription refill procedure by contacting their doctor. *Id.* at col. 7, ll. 19-24. In other words, Sekura is directed to reminding patients to comply with their medication regime.

In contrast, the present invention claims a system that is automated, requires substantially no patient interaction, and is designed to facilitate prescribers (e.g., doctors) managing their patients' medications. The present invention is not used by patients and does not assist patients with medication compliance. Furthermore, the present application discloses and claims a method for “renewing a pharmaceutical prescription via an electronic network.” *See* Present Application, pg. 6, lines 21-22 and claims. The renewal procedures calculate when a prescription will expire, sets a renewal date prior to that date, and periodically determines whether the renewal date has been reached. *Id.* at pg. 11, lines 26-31. Once reached, the renewal procedures electronically and without human intervention, generates a prescription renewal request. The prescription renewal request is then transmitted electronically to a prescriber asking whether the prescriber wishes to renew the patient's prescription. *Id.* at pg. 13, lines 9-15. In other words, unlike Sekura, the present invention is not used by a patient, does not alert a user (where the user is a patient as in Sekura), and does not aid a patient with managing medication regimes. Rather, the present invention requires a prescription renewal system that transmits a prescription renewal request to a prescriber, (e.g., a doctor). *See also* Present Application, pg. 6, lines 21-22 and claim. Accordingly, Sekura does not disclose, teach or suggest 1) transmitting a renewal request to a prescriber, as required by independent claim 1; 2) displaying a downloaded prescription renewal request to a prescriber, as required by claim 22; or 3) instructions for transmitting a renewal request to a prescriber, as required by claim 24.

Moreover, Sekura does not teach that a generation of a prescription renewal request occurs without patient intervention. First, Sekura in no way discloses, teaches or suggests a generation of any request, let alone a renewal request. Indeed, the term “renewal” is not

¹ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
1-PA/3518819.1

disclosed in the Sekura description at all. Second, Sekura does not disclose, teach, or suggest that generation of a renewal request occurs without patient intervention.

In contrast, the system of the present application provides a patient independent system that is focused on alerting the prescriber of a soon to expire prescription and provides the prescriber with a means for easily, conveniently, and electronically renewing a patient's prescriptions prior to expiration.

In light of the above, the independent claims of the present invention cannot be unpatentable over the currently cited art, as neither Mayaud, nevoca nor Sekura disclose, teach or suggest all of the limitations of the independent claims.

In view of the foregoing remarks and amendments, it is believed that the application is in form for allowance. Should the Examiner have any continuing objections or concerns, the Examiner is respectfully asked to contact the undersigned attorney in order to expedite allowance of this case. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (matter no. 061018-0008).

Respectfully submitted,

Date September 30, 2004


Dion M. Bregman

45,645

(Reg. No.)

MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306
(650) 843-7519